

Appl. No. 09/912,730
Amdt. dated October 9, 2008
Reply to Office action of June 13, 2008

Remarks/Arguments

The sole issue remaining in this application is whether the subject matter of claims 1-3 and 6-12 complies with the statutory requirements of 35 U.S.C. 101. It is the Examiner's holding that the claims are not in compliance since the claims 1) are not tied to another statutory class or do not transform underlying subject matter to a different thing.

For the following reasons, it is applicants' position that the claims do meet the requirements of 35 U.S.C. 101 and that the Examiner's construction of the USPTO Guidelines is unduly restrictive, leaving out another basis for compliance with 35 U.S.C. 101 that is, in fact, the very basis applicable to applicants' claims. Specifically, no physical transformation is required if the claims define a method which "produces a useful, concrete, and tangible result".

Under the USPTO Guidelines, the Examiner is required to consider four questions:

1. Does the claimed invention fall within one of the four statutory categories?
2. Does the claimed invention fall within a judicial exception?
3. Does the claimed invention provide a practical application?
4. Does the claimed invention wholly preempt all substantial applications of a judicial exception?

Regarding Question No. 1, 35 U.S.C. §101 reads: "Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title." As stated in the Guidelines, a "process" defines actions i.e. inventions that set forth a series of steps or acts to be performed. This is often done in the form of method claims. The

present claims explicitly define a method for transferring a non-monetary asset of a donor from the donor's account with an asset holder holding said non-monetary asset to a qualified charitable organization for subsequent transfer to at least one charity, and a method for transferring an asset of a donor from the donor's account with an asset holder holding said asset to a qualified charitable organization for subsequent transfer to at least one charity.

Regarding Question No. 2, the only three judicial exceptions are: Laws of nature, per se; Natural phenomena, per se; and Abstract ideas, per se. Clearly, neither of these exceptions is remotely related to the presently claimed method.

Regarding, Question No. 3, the invention has a practical application, namely, providing a method to facilitate transfer of an asset from a donor's account with an asset holder holding the asset to a qualified charitable organization for subsequent transfer to at least one charity. Contrary to the Examiner's interpretation, there are two ways in which an invention can have a practical application: "Physical Transformation, **OR Produce a Useful, Concrete, and Tangible Result**".

As stated in the Guidelines: "If no physical transformation appears in the claim then the next step in the analysis is to determine if the claim is otherwise directed to a useful, concrete and tangible result. The focus is on the result of the claim as a whole, not the individual steps or structure used to produce the result". The claimed invention as a whole must satisfy the utility requirement of 101: specific, substantial, and credible utility. The claims explicitly define the specific result that is obtained, i.e., the transfer of an asset from a donor's account with an asset holder holding the asset to a qualified charitable organization for subsequent transfer to at least one charity. The claimed method has a result that can be substantially repeated and is,

accordingly, concrete.

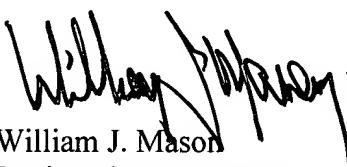
As stated in the Guidelines: "The tangible requirement does not necessarily mean that a claim must either be tied to a particular machine or apparatus, or must operate to change articles or materials to a different state or thing. To be tangible the claim must recite more than a § 101 judicial exception, in that the process claim must set forth a practical application of that § 101 judicial exception to produce a real-world result." Here, the claimed method sets forth a practical application, with a real-world result, i.e., the transfer of an asset from one entity to another at the direction of the asset owner.

Regarding Question No. 4, applicants' claims do not preempt every "substantial practical application" of an abstract idea, law of nature or natural phenomena.

Claims 21-34 stand withdrawn.

Accordingly, in view of the amendments to the claims and for the foregoing reasons, it is believed that this application is now in condition for allowance. Issuance of a Notice of Allowance is respectfully requested.

Respectfully submitted,



William J. Mason
Registration No. 22,948

Date: October 9, 2008
File No. 5441-001